

REMARKS

The undersigned attorney, on behalf of the applicants and for himself, thanks Examiner Prone for participating in a telephone interview on August 29, 2007 with the undersigned attorney. Although no final agreement was reached, the conversation was helpful and appreciated. As was indicated during the interview, the undersigned attorney urges the Examiner to call with any questions and/or suggestions that the Examiner may have to facilitate the present process and bring the present prosecution to a successful conclusion.

4. Claims 33 and 35 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,758,426 ("Richter").

Anticipation under 35 U.S.C. §102 requires that a single prior art reference disclose each and every limitation of the claimed invention. *Moba, B.V. , Staalkat, B.V. and FPS Food Processing Systems, Inc. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1321 (Fed. Cir. 2003)

The rejection provides that Richter discloses "a cutting edge (33) defined by first and second edge surfaces (35), the first edge surface extends between the first lateral side and the second edge surface, and the second edge surface extends between the second lateral side and the first edge surface (35)." Applicants respectfully disagree with the aforesaid characterization and the rejection based thereon.

As can be seen in Richter's FIG. 4 (shown below), Richter discloses a one-piece cutter wheel 21 that has a cutter structure 33 that includes a pair of surfaces 35 meeting at a cutting edge, which cutter structure 33 is disposed between a pair of side cylindrical portions 31. (Col. 3, lines 61-67)

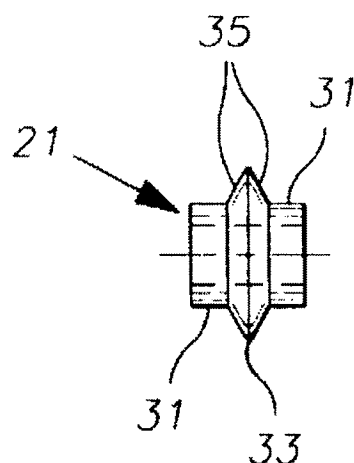


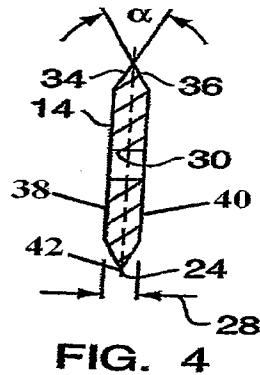
FIG. 4

The circular cutting blade recited in claims 33, 35, and new 36, in contrast, includes, *inter alia*:

(i) a maximum thickness extending between a first lateral side and a second lateral side; and

(ii) a cutting edge defined by a first edge surface and a second edge surface, wherein the first edge surface extends between the first lateral side and the second edge surface, and the second edge surface extends between the second lateral side and the first edge surface.

FIG. 4 of the present application illustrates the thickness 28 of the cutting blade extending between the lateral sides 38, 40, and therefore defines the position of the lateral sides 38, 40:



It can be clearly seen from FIG. 4 of Richter that surfaces 35 which meet at the cutting edge, do not extend between a lateral side and the opposite edge surface, as is recited in claims 33, 35 and 36. On the contrary, Richter discloses that each surface 35 extends to a cylindrical portion 21 that in turn, extends out to a lateral side. Applicant also respectfully directs the Examiner to col. 4, lines 16-18 of Richter where the width (i.e., the thickness) of the cutter wheel 21 is defined: "the width of the slot 25 is about 0.5 inches wide, as will be the width of the cutter wheel 21". In fact, the rejection subsequently relies upon this very passage to establish the relationship between the diameter and the width of the cutter wheel 21. Consequently, it is clear that the axially extending surfaces of the cylindrical portions 21 are not lateral sides, and the edge surfaces 35 do not, therefore extend out to lateral sides. For at least these reasons, it can be seen that Richter does not disclose the claimed invention and therefore cannot anticipate the invention of claims 33, 35 and 36.

In addition, however, Richter also does not disclose a rotary cutter having a handle or means operable to permit a cutting blade to travel in either a multi-directional path (claim 33) or a directionally unrestricted path (claims 35-37) across thin sheet material.

Richter discloses a rotary can opening cutter that includes round base portion 13 and a projecting stem portion 15.

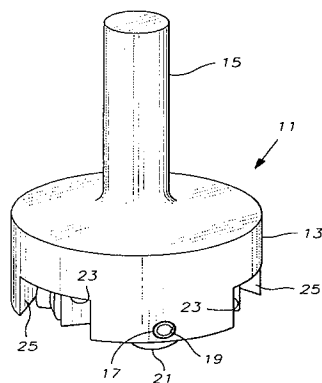


FIG. 1

Richter discloses that the stem portion 15 is engaged by a rotary motive device. (Col. 2, lines 54-55). Cutting is accomplished by the rotary motive device rotationally driving the rotary can opening cutter. The rotary can opening cutter requires an amount of vertical force sufficient to drive the cutter wheels necessary through the metal top.

There is no disclosure within Richter that the rotary can opening cutter can be operated by hand, and/or that the projecting stem portion 15 has a hand grip portion as is recited in claims 33 and 35-37. On the contrary, Richter discloses that the rotary can opening cutter requires a rotary motive device.

Furthermore, the rotary can opening cutter disclosed by Richter is limited to rotation in a single circular path and therefore is physically incapable of permitting any of the cutting blades to travel a multi-directional path (claim 33) or a directionally unrestricted path (claims 35-37).

In the "Response to the Arguments" section of the Office Action, the rejection provides:

In response to applicant's argument that the prior art fails to disclose travel in unrestricted movement and or multi-directional movements, a recitation of the intended use of the claim must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The aforesaid comments were made in the context of rejections of prior art (i.e., Belcourt) now not utilized by the Examiner and therefore are not specifically applicable

to the present rejections, which are now being rebutted for the first time. To the extent that the same issue applies to the present rejection, however, applicants offer the following comments.

Applicants respectfully submit that the characterization of applicants argument (i.e., “that the prior art fails to disclose travel in unrestricted movement and or multi-directional movements”) is not accurate. The rotary cutter recited in claim 33 includes a handle having a hand grip portion and an axle on which the cutting blade is pivotally mounted to rotate about its axis, wherein the manner in which the cutting blade is mounted on the handle permits the rotary cutter to travel a multi-directional path across the thin sheet material. The underlined language specifically defines the physical relationship between the handle and the cutting blade. It is not an intended use. The utilization of functional language to define “structural attributes of interrelated component parts of [a] claimed assembly” is perfectly acceptable practice. See *In re Venezia*, 530 F.2d 956 (CCPA 1971), which case is cited in MPEP 2173.05(g).

Similarly, claim 35 includes a handle having a hand grip portion and an axle on which the cutting blade is pivotally mounted, wherein the handle is operable to permit the cutting blade to travel in a directionally unrestricted path across the thin sheet material. Here again, the underlined language specifically defines the physical relationship between the handle and the cutting blade, the language is not an intended use, and utilization of such functional language is perfectly acceptable practice.

New Claim 36 recites a rotary cutter comprising, *inter alia*, “means having a hand grip portion and an axle on which the cutting blade is pivotally mounted, wherein the means is operable to permit the cutting blade to travel in a directionally unrestricted path across the thin sheet material.” Like the language in claims 33 and 35, this means-plus-function type clause specifically defines in functional terms the physical relationship between the handle and the cutting blade, and does not describe an intended use. The use of means-plus-function language is provided for in 35 U.S.C. §112(6). In construing such language, the PTO must look to the specification of the application (see *In re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994)), which specification clearly describes the physical relationship between the handle and the cutting wheel and the advantages

associated therewith (e.g., safety, ability to follow directionally unrestricted paths including sharp corners, etc.).

In sum, for all of the reasons above, applicants respectfully submit that claims 33 and 35-37 are not disclosed within Richter, and Richter cannot therefore anticipate the rotary cutter of claims 33 and 35-37 under 35 U.S.C. §102.

4. Claims 33 and 35 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,740,848 (“Lindley”) in view of Richter. The rejection indicates that Lindley includes “a handle having a grip portion (21) and an axle on which the cutting blade is pivotally mounted (35), the cutting blade and the manner in which it is mounted on the handle permits the cutter to travel a multi-directional path (Fig. 2 and Fig. 3), and the handle is operable to permit the cutting blade to travel is [sic] a directionally unrestricted path (Fig.1).” The rejection provides further that “Richter teaches that it is old and well known for rotary cutters for metal to incorporate an edge angle defined by first and second edge surfaces that is not less than 40° and not greater than 50°.” Applicants respectfully disagree with the aforesaid characterization and the rejection based thereon.

Applicants respectfully direct the Examiner to the remarks above relating to Richter.

Lindley discloses a Rotary Cutter Assembly that includes a handle 21 that is pivotally mounted to a pair of angle supports 25, 27. The assembly further includes a cutting wheel 3 that is mounted on a channel shaped bar 7. The channel shaped bar 7 includes lateral flanges 9, 11. A rack 13 is connected to the lateral flanges 9, 11. The handle includes a gear 23 that engages the rack 13, and therefore is not attached to the rack 13. It is clear from the description of Lindley that the Assembly does not include a handle having a hand grip portion and an axle on which the cutting blade is pivotally mounted (claims 33 and 35), or means having a hand grip portion and an axle on which the cutting blade is pivotally mounted (claim 36). On the contrary, the handle is independent of the cutting wheel 21, connected only by a rack and gear arrangement that moves the channel shaped bar 7 in a restricted linear motion.

In view of the fact that this rejection relies on Lindley for all aspects of the claimed invention other than the cutting wheel geometry, which is allegedly disclosed by Richter, applicants respectfully submit that the references do not disclose all of the elements recited in claims 33 and 35-37. Absent some undisclosed modification, the claimed invention cannot therefore be obvious in view of the cited references.

In addition, however, applicants respectfully submit further that the cited references also do not disclose a handle having a hand grip portion and an axle on which the cutting blade is pivotally mounted to rotate about its axis: 1) wherein the manner in which the cutting blade is mounted on the handle permits the rotary cutter to travel a multi-directional path; (claim 33) or 2) wherein the handle is operable to permit the cutting blade to travel in a directionally unrestricted path (claim 35); or alternatively, a means having a hand grip portion and an axle on which the cutting blade is pivotally mounted, wherein the means is operable to permit the cutting blade to travel in a directionally unrestricted path across the thin sheet material (claim 36). As indicated above, the rotary can opening cutter disclosed by Richter is limited to rotation in a single circular path and therefore is physically incapable of permitting any of the cutting blades to travel a multi-directional path or a directionally unrestricted path, and the cutting wheel 3 of Lindley is restricted to a linear motion along a single path.

For at least these reasons, the applicants respectfully submit that the hand-held rotary cutter recited in claims 33 and 35-37 is not disclosed by the cited references and is not obvious in view thereof. Applicants, therefore, respectfully request the present rejection be withdrawn and claims 33 and 35-37 be passed to issuance.

As indicated above, applicants and the undersigned attorney appreciate the Examiner's participation in the interview of August 29, 2007. Because the present prosecution has extended for a substantially longer than normal duration, and because the present Examiner was not the original Examiner in the present case, applicants would like to reiterate some of the qualities and characteristics of the present invention that were made of record early in the prosecution (prior to his participation) and that highlight the novelty and uniqueness of the present invention over all of the cited prior art and all that applicants are aware of.

First of all, the present specification clearly identifies shortcomings of prior art rotary cutters for thin sheet materials such as paper, cloth and plastic. Those shortcomings include less than optimum durability, susceptibility to mechanical damage, operator safety concerns, undesirable ease of use, and limitations regarding the ability of the cutter to cut thin sheet materials along a directionally unrestricted path; e.g., along small radii or other sharp turns. All of the cited prior art suffer from one or more of these shortcomings.

The applicants recognized these shortcomings and specifically designed the present rotary cutter to overcome them. As is indicated in the specification, the present rotary cutter overcomes the safety and ease of use issues of the large diameter blades by using a cutting blade that has a much smaller diameter than is used in existing rotary cutter blades, and one that has a much broader edge angle than is found on existing rotary cutting blades. The present invention rotary cutter also provides advantageous durability. Applicant's declaration of September 6, 2002 attests to this durability.

The aforesaid qualities of the present rotary cutter are not provided by any of the sheet metal can opener prior art references cited during this prosecution. Nor would they be predictable in view thereof. Can openers by nature are directed toward a different problem entirely. Such devices require an application of force far greater than can be applied by the present rotary cutter; e.g., many prior art can openers utilize significant mechanical advantage and/or a rotary powered drive to enable them to cut sheet metal. Consequently, the present rotary cutter cannot be used as a can opener. Can openers also drive a cutting wheel in a defined, preset direction. There is no reason or need to have a handle that is operable to enable the cutting wheel to travel in a multi-directional or a directionally unrestricted path across a thin sheet material. In short, the claimed rotary cutter is a unique device that overcomes many of the shortcomings of the prior art in an art that is nonanalogous to the can opener art. As such, the present device is novel device, one that cannot be predicted from any of the prior art alone or in combination, and one that is therefore nonobvious.

As applicants have traversed the objection and rejections raised by the Examiner, it is respectfully requested that the Examiner withdraw the stated objection and rejection,

allow claims 33 and 35-37, and pass the present application on to issuance. Applicants do not believe any fee is due herewith. In the event a fee is due, however, please charge our Deposit Account No. 50-3381.

In addition, the undersigned attorney is available to discuss the present application at the Examiner's convenience.

Respectfully submitted,

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